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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/295,230	04/19/1999	CHRISTOPHER EWING	3175.01A	6950

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EXAMINER

DIXON, THOMAS A

ART UNIT	PAPER NUMBER
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2161

DATE MAILED: 02/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/295,230

Applicant(s)

EWING, CHRISTOPHER

Examiner

Thomas A. Dixon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 28-33 is/are rejected.
- 7) ☒ Claim(s) 21-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment of the claims overcomes the art of record, Baron et al (5,809,481).

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1, 3-6, 11-18, 30-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Specifically, the claims only collect and manipulate data, but do not produce a useful, tangible and concrete product.

### ***Claim Objections***

3. Claims 1 and 17 are objected to because of the following informalities:

As per Claim 1, the word "revealed" in line 9, should be followed by "to".  
As per Claim 17, the word "gee" in line 2, should be "fee".  
Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112 1<sup>st</sup> Paragraph***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 1-18, 30-32 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The web site critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re*

*Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Specifically, the web site (current claim 33) enables the gift exchange to take place because it stores the required pseudonymous and non-pseudonymous data and creates the orders.

***Claim Rejections - 35 USC § 112 2<sup>nd</sup> Paragraph***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites the limitation "including issuing said order that said gift be sent" in lines 2/3. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-4, 10-12, 19, 28-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Kelly et al (6,306,035).

As per Claim 1.

Kelly et al ('035) discloses:

receiving a request over the internet from said first party for a gift to be sent to a second party, see column 11, lines 47-56;

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obtaining over the internet from said first party, a pseudonym of said second party, see column 11, lines 47-56;

securing over the internet a non-pseudonymous name and address associated with the second party's pseudonym, see column 10, lines 39-51 for enabling said gift to be sent to said second party while said non-pseudonymous name is not revealed to said first party, see column 11, lines 47-56.

As per Claim 2.

Kelly et al ('035) discloses all the limitations of claim 1.

Kelly et al ('035) further discloses issuing an order that the gift be sent to said second party's non-pseudonymous name and address, see column 11, lines 47-64.

As per Claim 3.

Kelly et al ('035) discloses all the limitations of claim 1.

Kelly et al ('035) further discloses the step of securing a non-pseudonymous name and address associated with said second party's pseudonym is carried out by looking up said party's pseudonym in a database, see column 8, lines 65-68, column 10, lines 39-51, and column 11, lines 47-53.

As per Claim 4.

Kelly et al ('035) discloses all the limitations of claim 1.

Kelly et al ('035) further discloses contacting said second party and requesting revelation of said second party's non-pseudonymous name and address, see column 10, lines 39-51.

As per Claim 10.

Kelly et al ('035) discloses all the limitations of claim 1.

Kelly et al ('035) further discloses electronically communicating to a third party an order that said gift be sent, see column 11, lines 47-56 and column 12, lines 37-45.

As per Claim 11.

Kelly et al ('035) discloses all the limitations of claim 1.

Kelly et al ('035) further discloses electronically giving said first party an opportunity to reveal true identity information about said first party's self, see column 11, lines 47-53.

As per Claim 12.

Kelly et al ('035) discloses all the limitations of claim 1.

Kelly et al ('035) further discloses electronically giving said second party an opportunity to reveal true identity information about said second party's self, see column 10, lines 39-51.

As per Claim 19.

Kelly et al ('035) discloses:

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computers respectively for said parties, see figure 1, (computers 110 and unnumbered);

a web site, see (102), operably connected to said computers, enabling said first party to send a gift to said second party by a pseudonym of said second party without said web site revealing a non-pseudonymous name to said first party, see column 10, line 58 – column 11, line 10 and column 11, lines 47-56.

As per Claim 28.

Kelly et al ('035) discloses all the limitations of claim 19.

Kelly et al ('035) further discloses the web site enables said first party to reveal or maintain confidentiality of true identity information of said first party, see column 10, line 58 – column 11, line 10 and column 11, lines 47-56.

As per Claim 29.

Kelly et al ('035) discloses all the limitations of claim 19.

Kelly et al ('035) further discloses the web site enables said second party to reveal or maintain confidentiality of said second party's true identity information, see column 10, lines 31-33.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-14, 16, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al (6,306,035) in view of Akel et al (5,457,305) further in view of Walker et al (6,330,544).

As per Claim 13.

Kelly et al ('035) discloses all the limitations of claim 1.

Kelly et al ('035) does not specifically disclose electronically charging the fee.

Akel et al ('305) teaches electronically charging a fee for a transaction, see column 2, lines 18-22 for the benefit of recovering the costs associated with providing a service to card holders.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Kelly et al ('035) to electronically

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charge a fee for a gift, as taught by Akel et al ('305) for the benefit of recovering the costs associated with providing a service to card holders.

As per Claim 14.

Kelly et al ('035) in view of Akel et al ('035) discloses all the limitations of claim 13.

Kelly et al ('035) does not specifically disclose charging to a credit card.

Akel et al ('305) teaches the fee is electronically charged to a charge card, see column 1, lines 50-54 and column 2, lines 18-22 for the benefit of recovering the costs associated with providing a service to card holders.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Kelly et al ('035) to electronically charge a credit card, as taught by Akel et al ('305) for the benefit of recovering the costs associated with providing a service to card holders.

As per Claim 16.

Kelly et al ('035) discloses all the limitations of claim 1.

Kelly et al ('035) further discloses costs associated with gifts, see column 11, lines 53-56.

Kelly et al ('035) does not specifically disclose electronically charging the fee to said first part for carrying out steps up to and including issuing said order that said gift be sent.

Akel et al ('305) teaches electronically charging a fee for a transaction, see column 2, lines 18-22 for the benefit of recovering the costs associated with providing a service to card holders.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Kelly et al ('035) to electronically charge a fee for a gift giving transaction, as taught by Akel et al ('305) for the benefit of recovering the costs associated with providing a service to card holders.

As per Claim 20.

Kelly et al ('035) discloses all the limitations of claim 19.

Kelly et al ('035) does not specifically disclose electronically charging the fee.

Akel et al ('305) teaches electronically charging a fee for a transaction, see column 2, lines 18-22 for the benefit of recovering the costs associated with providing a service to card holders.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Kelly et al ('035) to electronically charge a fee for a gift, as taught by Akel et al ('305) for the benefit of recovering the costs associated with providing a service to card holders.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al (6,306,035) in view of Akel et al (5,457,305) further in view of Walker et al (6,330,544).

As per Claim 15.

Kelly et al ('035) in view of Akel et al ('305) discloses all the limitations of claim 13.

Kelly et al ('035) further discloses sending a confirmation message, see column 10, lines 49-51.

Kelly et al ('035) does not specifically disclose confirming receipt of the gift order before electronically charging said fee to said first party.

Walker et al ('544) teaches the fee is electronically charged to a charge card after the gift card is presented for redemption, see column 3, lines 31-35 for the benefit of not charging a card holder's account until the gift certificate has been redeemed.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Kelly et al ('035) to confirm receipt of the gift order before electronically charging a credit card, as taught by Walker et al ('544) for the benefit of not charging a card holder's account until the gift certificate has been redeemed.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al (6,306,035) in view of Walker et al (6,330,544).

As per Claim 17.

Kelly et al ('035) discloses all the limitations of claim 1.

Kelly et al ('035) further discloses costs associated with gifts, see column 11, lines 53-56.

Kelly et al ('035) does not specifically disclose electronically charging a second fee to said first party, wherein said second fee is related to the value of said gift.

Walker et al (6,330,544) teaches electronically charging a fee for a gift, see column 1, lines 36-50 and column 3, lines 31-35 for the benefit of giving card holders greater gift giving abilities.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made to modify the invention of Kelly et al ('035) to electronically charge a fee for a gift, as taught by Walker et al ('544) for the benefit of giving card holders greater gift giving abilities.

### ***Allowable Subject Matter***

10. Claims 5-7, 18, 21-27 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and overcome the outstanding 112 and 101 rejections.




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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas A. Dixon whose telephone number is (703) 305-4645. The examiner can normally be reached on Monday - Thursday 6:30 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (703) 305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7293 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

TAD   
January 30, 2002

  
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